REMARKS

Applicant respectfully requests reconsideration of the present application. No new matter has been added to the present application. Claims 1-23 have been rejected in the Office Action. No claims have been amended, new claim 24 has been added, and no claims have been canceled in this Amendment. Accordingly, claims 1-24 are pending herein. Claims 1-24 are believed to be in condition for allowance and such favorable action is respectfully requested.

Interview Summary

Applicants' representative thanks the Examiner for granting a personal interview on March 13, 2007, attended by Applicant, Piero Sierra, Applicants' representative, John Golian, Examiner Ke, and Examiner Sax. During the interview, differences between the claimed invention and the cited references, namely U.S. Patent No. 6,781,611 (the "Richard reference") and U.S. Patent No. 6,160,554 (the "Krause reference") were discussed. Additionally, an exhibit demonstrating an embodiment of the invention was presented to Examiners Ke and Sax to highlight some of these differences. Applicants' representative argued that differences between embodiments of the invention and the cited art are captured in the pending claims, for instance, in the recited feature of providing an "extracted graphical preview of the content" of an open application window, in context of other features recited in the claims. However, the Examiner indicated that he believed an additional limitation would help clarify differences and overcome the cited art. Accordingly, Applicants have added new claim 24 herein including the feature "displaying an extracted graphical preview comprising a live running view of actual content currently within one of the plurality of open application windows." Applicants respectfully submit that the recited feature overcomes the cited art. Applicants have not amended claims 1-

23, thereby presenting the claims for further consideration by the Examiner in view of the arguments presented herein.

Amendments to the Claims

New claim 24 has been added in this Amendment. Care has been exercised to avoid the introduction of new matter. Support for new claim 24 may be found in the Specification, for example, at p. 1, lines 12-16; p. 2, lines 3-7; p. 11, lines 11-14; and p. 15, lines 20-21.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel,* 292 F. 2d 955, 956-957 (1961). Thus, in order "[t]o establish a *prima facie* case of obviousness, three basic criteria must

be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *See* MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application]." *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

B. Rejections based on Richard and Krause

Claims 1, 2, 7, 8, 15, 16, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,781,611 (the "Richard reference") in view of U.S. Patent No. 6,160,554 (the "Krause reference"). As a *prima facie* case of obviousness has not been established, Applicants respectfully traverse this rejection, as hereinafter set forth.

1. Lack of Suggestion or Motivation to Combine the Cited References

Factual findings in support of a *prima facie* case of obviousness must be supported by substantial evidence. *In re Zurko*, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001). "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusions that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte*

Clapp, 227 USPQ 972, 973 (Bd. Pat App. & Inter. 1985)." MPEP § 2142. MPEP § 2142 further states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *Dembiczak*, 50 USPQ2d at 1617. "'The factual inquiry whether to combine the references must be thorough and searching.'" *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. *Id.* at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. *In re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). The Office must "determine whether there was an apparent reason to combine the known elements in the fashion claimed." *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

The Office Action has not presented sufficient evidence why someone of ordinary skill in the art would have combined the Richard and Krause references. Instead of showing objective evidence of a proper motivation or suggestion, the Office Action has cited simply the benefits of features that are present in one reference but are missing in the other reference as the motivation. By extracting the relevant parts from each of the two references and combining those parts, the Office Action has effectively recreated the invention by using the claim as a blueprint, thereby using impermissible hindsight. Neither the Richard reference nor the Krause

reference discloses or suggests a motivation to combine with the other to achieve the claimed invention. The Office Action argues that the Krause reference provides motivation stating that it recognizes a "'need for fast, convenient, and reliable technique for determining the contents or intended use of' the application window 'without depending upon the name' of the window.'" Office Action, p. 12. Applicants respectfully submit that this statement is a mischaracterization of the Krause reference. The Krause reference is directed to unopened files and is not concerned with open application windows as suggested in the Office Action. Static, unopened files as in the Krause reference are significantly different than open and running applications windows at which embodiments of the present application are directed (this difference is discussed in further detail below). Moreover, the above-noted statement in the Office Action completely ignores the remainder of the sentence cited from Krause reference that, as explained in further detail below, teaches away from a combination with the Richard reference. In particular, the Krause reference states that there is a need to determine the contents of a file "without depending upon launching an application capable of reading the file." Krause, col. 1, lines 44-48. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP 2141.02. Accordingly, the Office Action fails to present any apparent reason why one of ordinary skill would have been motivated to combine or otherwise modify the references to achieve the invention of claims 1, 2, 7, 8, 15, 16, and 23. Therefore, the combination is improper and must be withdrawn.

2. *The Cited References Are Improperly Combined*

Applicants also respectfully submit that the Richard and Krause references were improperly combined because the Krause reference teaches away from a combination with the Richard reference. "[I]t is improper to combine references where the references teach away from

their combination." MPEP § 2145. The Richard reference discusses a plurality of application windows must be open and running. However, the Krause reference disparages this element as disadvantageous in at least three locations: (1) "Another option available to the computer operator is to launch an application capable of interpreting the format of the file he wishes to use or view. This solution consumes both time and resources. The operator has to wait for the application to load and run before he can view the file." Krause, col. 1, lines 33-37. (2) "In a preferred embodiment, the invention provides the ability to view an abbreviated description of a file's content or intended use without the operator having to explicitly open it using an application designed to interpret the file's contents, or to execute it." Krause, col. 1, lines 52-56. (3) "Using the teachings of the present patent document, the operator does not have to... read the contents of the file by launching an application program for that purpose." Krause, col. 1, line 66 to col. 2, line 3. Thus, the Krause reference does not contemplate a plurality of open applications, and in fact, teaches away from such an environment and thus teaches away from a combination with the Richard reference. Accordingly, the combination of the Richard and Krause references is improper and should be withdrawn.

The Examiner has argued that the Krause reference does not teach away from a combination with the Richard reference, for example, by indicating that "[e]ven if one reference is designed for open application and the other is designed for unopened file, it does not mean that the references are teaching away from each other." *See, e.g.,* Advisory Action dated 6/16/2005. However, this conclusions oversimplifies this issue and ignores the teachings from the Krause reference indicated above that teach away from a combination with the Richard reference. First, an open application and an unopened file are significantly different (as described in further detail below with respect to the cited references' failure to teach or suggest the claimed invention). As

such, there is no motivation or suggestion to combine the teachings of the Krause reference with the Richard reference. Second, the Krause reference teaches a system that is not just designed for an unopened file but is specifically designed such that a user would not have to open a file using an application to view the file's content. As indicated by the statements quoted above, the Krause reference is explicitly directed to preventing a user from having to open a file in an application. Accordingly, the Krause reference teaches away from a combination with a reference that is directed to switching between open windows of an application.

3. References Fail to Teach or Suggest All Claim Limitations

Even if the Richard and Krause references were combined, the combination of the references would fail to teach or suggest all the claim limitations of each of claim 1, 2, 7, 8, 15, 16, and 23. The Office Action indicates that the Richard reference fails to teach or suggest displaying an extracted graphical preview of the content of an open application window and relies upon the Krause reference for this limitation. Office Action, p. 3. Applicants respectfully submit that the Krause reference also fails to teach or suggest "displaying an extracted graphical preview of the content for one of the plurality of open application windows" as recited by claims 1, 2, 7, 8, 15, 16, and 23. In contrast, the Krause reference is directed to determining the content of a closed file without having to open the file. By placing a mouse cursor over a file icon or by performing a series of mouse clicks, a window may be generated that provides preview information (e.g., meta-data) for the unopened file. The present invention is concerned with providing an extracted graphical preview of the content of an open application window, not with determining the content of a single, unopened file. Applicants respectfully submit that an open application window is significantly different from a file. Additionally, Applicants respectfully submit that displaying an extracted graphical preview of the content of an open application

window as claimed is significantly different from displaying content associated with a single, unopened file as discussed in the Krause reference.

The Office Action appears to be assuming that because a file may be opened in an application, the content of an open application window must correspond with the content of a file. However, Applicants respectfully submit that this is incorrect. An open application window in some cases may not be associated with a file, and, accordingly, the content of the open application window in such cases will likewise not correspond with a file. For example, an open application window may not have any file or document associated with the window (e.g., if no file or document has been opened in the application window). In the context of an application window for viewing and organizing files and folders, the content within the window may consist of a list of files and/or folders, which in no way corresponds with the content of a single file. As another example, the content of a window for an e-mail application may consist of a list of e-mail messages (e.g., the inbox of an e-mail application), which likewise does not correspond with the content of a file. As a further example, the content of a window for a multimedia player may include a video that is currently playing in the multimedia player (e.g., the extracted graphical preview would be the playing video). In other cases, an open application window may include multiple documents (e.g., when comparing two word processing documents side-by-side).

As such, the Krause reference, which discusses providing a preview of content of an unopened file, simply does not teach or suggest displaying an extracted graphical preview of the content for an open application window as recited by claims 1, 2, 7, 8, 15, 16, and 23. Accordingly, Applicants respectfully submit that the references fail to teach or suggest all of the limitations of claims 1, 2, 7, 8, 15, 16, and 23, and, thus, a *prima facie* case of obviousness has

not been established.

For the reasons stated above, Applicants respectfully submit that claims 1, 2, 7, 8, 15, 16, and 23 are non-obvious over the Richard reference in view of the Krause reference. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 2, 7, 8, 15, 16, and 23 under 35 U.S.C. § 103(a). Claims 1, 2, 7, 8, 15, 16, and 23 are believed to be in condition for allowance and such favorable action is respectfully requested.

C. Rejections based on Richard, Krause, and Staab

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Richard reference in view of the Krause reference further in view of U.S. Patent No. 5,499,334 (the "Staab reference"). The rejections of claim 3 and 4 each rely in part on the combination of Richard and Krause similar to the rejections for claims 1, 2, 7, 8, 15, 16, and 23. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons.

The Office Action also indicates that the combination of the Richard and Krause references fails to teach upon receipt of the switching input, displaying a preview for each of the plurality of open application windows. Office Action, p. 5-6. The Office Action relies upon the combination of the Staab reference to teach this limitation. *Id.* However, Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness for claims 3 and 4 regarding the combination of the Staab reference with the Richard and Krause references as hereinafter set forth.

1. Lack of Suggestion or Motivation to Combine the Cited References

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. The Office Action has not presented any evidence why the Staab reference would

have been combined with the Richard and Krause references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. *Id.* The sole support in the Office Action for such a combination is that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Staab with the method of Richard and Krause in order to provide an improved representation of a desktop space." Office Action, p. 5. The Office Action cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Office Action has not presented any actual evidence in support of the same. The Office Action simply fails to present any apparent reason why one of ordinary skill would have been motivated to combine or otherwise modify the references to achieve the invention of claims 3 and 4. Instead, the Office Action relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and should be withdrawn.

2. *References Fail to Teach or Suggest All Claim Limitations*

As mentioned above, the Office Action indicates that the combination of the Richard and Krause references fails to teach upon receipt of the switching input, displaying a preview for each of the plurality of open application windows as recited by claims 3 and 4. Office Action, p. 5-6. The Office Action relies upon the combination of the Staab reference to teach this limitation. However, Applicants respectfully submit that the Staab reference fails to teach or suggest displaying an extracted preview of the content for each of the plurality of open

applications windows. Rather, the Staab reference teaches a system and method for managing desktop configurations of inactive programs. A desktop or windows configuration is "the location and size (configuration) of each window on the display." Staab, col. 1, lines 44-47. The system discussed in the Staab reference allows a user to save a window configuration, modify the configuration while the applications are inactive, and then activate the saved configuration. Staab, col. 2, lines 14-28. When a window configuration is activated, the system "activates any currently-inactive programs that are associated with a saved window configuration." Staab, at col. 2, lines 28-30. Thus, the system in the Staab reference allows users to employ a saved desktop configuration to activate multiple applications with the window for each application configured on the desktop in the manner of the saved desktop configuration. However, the Staab reference lacks any teaching or suggestion of displaying a preview of the content of each of a plurality of application windows that are currently open. Accordingly, Applicants respectfully submit that the references fail to teach or suggest all of the limitations of claims 3 and 4, and, thus, a *prima facie* case of obviousness has not been established.

For the reasons stated above, Applicants respectfully submit that claims 3 and 4 are non-obvious over the Richard reference in view of the Krause reference and further in view of the Staab reference. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3 and 4 under 35 U.S.C. § 103(a). Claims 3 and 4 are believed to be in condition for allowance and such favorable action is respectfully requested.

D. Rejections based on Richard, Krause, and Kitami

Claims 5, 6, 9, 10, 12-14, 18, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Richard reference, in view of the Krause reference, and further in view of U.S. Patent No. 5,668,962 (the "Kitami reference"). The rejections of claim 5, 6, 9, 10,

12-14, 18, and 19 each rely in part on the combination of the Richard and Krause references similar to the rejections for claims 1, 2, 7, 8, 15, 16, and 23. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons.

The Office Action also indicates that the combination of the Richard and Krause references fails to teach the method wherein each of the plurality of open application windows is ranked according to an activation hierarchy, and wherein the displayed preview is the window immediately succeeding the current open application window in the activation hierarchy. Office Action, p. 6. The Office Action relies upon the combination of the Kitami reference to teach this limitation. *Id.* However, Applicants respectfully submit that the Office Action has failed to established a *prima facie* case of obviousness for claims 5, 6, 9, 10, 12-14, 18, and 19 regarding the combination of the Kitami reference with the Richard and Krause references as hereinafter set forth.

1. Lack of Suggestion or Motivation to Combine the Cited References

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. The Office Action has not presented any evidence why the Kitami reference would have been combined with the Richard and Krause references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. *Id.* The sole support in the Office Action for such a combination is that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Kitami with the method of Richard and Krause in order to provide a simplified method of selecting a

desired window." Office Action, p. 7. The Office Action cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Office Action has not presented any actual evidence in support of the same. The Office Action simply fails to present any apparent reason why one of ordinary skill would have been motivated to combine or otherwise modify the references to achieve the invention of claims 5, 6, 9, 10, 12-14, 18, and 19. Instead, the Office Action relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and should be withdrawn.

2. *References Fail to Teach or Suggest All Claim Limitations*

As mentioned above, the Office Action indicates that the combination of the Richard and Krause references fails to teach the method wherein each of the plurality of open application windows is ranked according to an activation hierarchy, and wherein the displayed preview is the window immediately succeeding the current open application window in the activation hierarchy. Office Action, p. 5-6. The Office Action relies upon the combination of the Kitami reference to teach this limitation. *Id.* However, Applicants respectfully submit that the Kitami reference fails to teach or suggest that each of the plurality of open application windows is ranked according to an activation hierarchy as required by claims 5, 6, 9, 10, 12-14, 18, and 19. Rather, the Kitami reference discusses a system for managing a number of windows using a window identifier list. *See* Kitami, at Abstract. The window identifier list includes window identifiers that are designated by a user. *Id.* Thus, the identifier list is only "a limited subset of all opened windows currently operating on the window system." *Id.* The Kitami reference lacks any teaching or suggestion of ranking each of the plurality of open application

windows according to an activation hierarchy. Accordingly, Applicants respectfully submit that the references fail to teach or suggest all of the limitations of claims 5, 6, 9, 10, 12-14, 18, and 19 and, thus, a *prima facie* case of obviousness has not been established.

For the reasons stated above, Applicants respectfully submit that claims 5, 6, 9, 10, 12-14, 18, and 19 are non-obvious over the Richard reference in view of the Krause reference and further in view of the Kitami reference. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 5, 6, 9, 10, 12-14, 18, and 19 under 35 U.S.C. § 103(a). Claims 5, 6, 9, 10, 12-14, 18, and 19 are believed to be in condition for allowance and such favorable action is respectfully requested.

E. Rejections based on Richard, Krause, Kitami, and Staab

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Richard reference in view of the Krause reference, in view of the Kitami reference, and further in view of the Staab reference.

The rejection of claim 11 relies in part on the combination of the Richard and Krause references similar to the rejections for claims 1, 2, 7, 8, 15, 16, and 23. Accordingly, claim 11 is believed to be in condition for allowance for at least the above-cited reasons. In addition, the rejection of claim 11 relies in part on the combination of the Kitami reference with the Richard and Krause references similar to the rejections for claims 5, 6, 9, 10, 12-14, 18, and 19. Accordingly, claim 11 is believed to be in condition for allowance for at least the above-cited reasons. Further, the rejection of claim 11 relies in part on the combination of the Staab reference similar to the rejections for claims 3 and 4. Accordingly, claim 11 is believed to be in condition for allowance for at least the above-cited reasons.

For the reasons stated above, Applicants respectfully submit that claim 11 is non-obvious over the Richard reference, in view of the Krause reference, in view of the Kitami reference, and further in view of the Staab reference. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 11 under 35 U.S.C. § 103(a). Claim 11 is believed to be in condition for allowance and such favorable action is respectfully requested.

F. Rejections based on Richard, Krause, and Pabon

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Richard reference, in view of the Krause reference, and further in view of U.S. Patent No. 6,429,855 (the "Pabon reference"). The rejections of claim 17 relies in part on the combination of the Richard and Krause references similar to the rejections for claims 1, 2, 7, 8, 15, 16, and 23. Accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons.

The Office Action also indicates that the combination of the Richard and Krause references fails to teach the method wherein the switching input comprises a keyboard input. Office Action, p. 9. The Office Action relies upon the combination of the Pabon reference to teach this limitation. *Id.* However, Applicants respectfully submit that the Office Action has failed to established a *prima facie* case of obviousness for claim 17 regarding the combination of the Pabon reference with the Richard and Krause references as hereinafter set forth.

1. Lack of Suggestion or Motivation to Combine the Cited References

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. The Office Action has not presented any evidence why the Pabon reference would have been combined with the Richard and Krause references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art

also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. *Id.* The sole support in the Office Action for such a combination is that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Pabon with the method of Krause and Kitami [sic] in order to allow a variety of commands to be selected by the user." Office Action, p. 9. The Office Action cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Office Action has not presented any actual evidence in support of the same. The Office Action simply fails to present any apparent reason why one of ordinary skill would have been motivated to combine or otherwise modify the references to achieve the invention of claim 17. Instead, the Office Action relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and should be withdrawn.

2. *References Fail to Teach or Suggest All Claim Limitations*

As mentioned above, the Office Action indicates that the combination of the Richard and Krause references fails to teach the method wherein the switching input comprises a keyboard input. Office Action, p. 9. The Office Action relies upon the combination of the Pabon reference to teach this limitation. *Id.* However, Applicants respectfully submit that the Pabon reference fails to teach or suggest that a switching input to switch between multiple open application windows comprises a keyboard input. Accordingly, Applicants respectfully submit that the references fail to teach or suggest all of the limitations of claim 17 and, thus, a *prima facie* case of obviousness has not been established.

For the reasons stated above, Applicants respectfully submit that claim 17 is non-obvious over the Richard reference in view of the Krause reference and further in view of the Pabon reference. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 17 under 35 U.S.C. § 103(a). Claim 17 is believed to be in condition for allowance and such favorable action is respectfully requested.

G. Rejections based on Richard, Krause, Kitami, and Pabon

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Richard reference, in view of the Krause reference, in view of the Kitami reference, and further in view of the Pabon reference.

The rejection of claim 20 relies in part on the combination of the Richard and Krause references similar to the rejections for claims 1, 2, 7, 8, 15, 16, and 23. Accordingly, claim 20 is believed to be in condition for allowance for at least the above-cited reasons. In addition, the rejection of claim 20 relies in part on the combination of the Kitami reference with the Richard and Krause references similar to the rejections for claims 5, 6, 9, 10, 12-14, 18, and 19. Accordingly, claim 20 is believed to be in condition for allowance for at least the above-cited reasons. Further, the rejection of claim 20 relies in part on the combination of the Pabon reference similar to the rejection for claim 17. Accordingly, claim 20 is believed to be in condition for allowance for at least the above-cited reasons.

For the reasons stated above, Applicants respectfully submit that 20 is non-obvious over the Richard reference, in view of the Krause reference, in view of the Kitami reference, and further in view of the Pabon reference. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 20 under 35 U.S.C. § 103(a). Claim 20 is believed to be in condition for allowance and such favorable action is respectfully requested.

H. Rejections based on Richard, Krause, and Swartz

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Richard reference in view of the Krause reference further in view of U.S. Published Application No. 2001/0028368 (the "Swartz reference"). The rejection of claim 21 relies in part on the combination of Richard and Krause similar to the rejections for claims 1, 2, 7, 8, 15, and 16. Accordingly, claim 21 is believed to be in condition for allowance for at least the above-cited reasons.

The Office Action also indicates that the combination of the Richard and Krause references fails to teach wherein the extracted graphical preview represents a screen shot of the content currently within an open application window. Office Action, p. 10. The Office Action relies upon the combination of the Swartz reference to teach this limitation. *Id.* However, Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness for claim 21 regarding the combination of the Swartz reference with the Richard and Krause references as hereinafter set forth.

1. Lack of Suggestion or Motivation to Combine the Cited References

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. The Office Action has not presented any evidence why the Swartz reference would have been combined with the Richard and Krause references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. *Id.* The sole support in the Office Action for such a combination is that "[i]t would have been obvious to an artisan at the time of the invention to include Swartz with the method of Richard and Krause

in order to allow users to preview application window [sic] at real time." Office Action, p. 10. The Office Action cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Office Action has not presented any actual evidence in support of the same. The Office Action simply fails to present any apparent reason why one of ordinary skill would have been motivated to combine or otherwise modify the references to achieve the invention of claim 21. Instead, the Office Action relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and should be withdrawn.

2. *References Fail to Teach or Suggest All Claim Limitations*

As mentioned above, the Office Action indicates that the combination of the Richard and Krause references fails to teach wherein the extracted graphical preview represents a screen shot of the content currently within an open application window. Office Action, p. 10. The Office Action relies upon the combination of the Swartz reference to teach this limitation. However, Applicants respectfully submit that the Swartz reference fails to teach or suggest an extracted graphical preview that represents a screen shot of the content currently within an open application window. Rather, the Swartz reference discusses a system and method that allows users to retrieve a document using a "file snapshot" that includes a graphical representation of the document at the time the document was open and captured by a user. *See, e.g.,* Swartz, Abstract; paragraphs [0005], [0029], and [0030]. The Swartz reference requires a user to manually capture a graphical representation of a document while it is open. *See id.*, [0005], [0029], [0030], and [0034]; FIG. 5; and FIG. 7. Accordingly, the "file snapshot" is a static graphical representation of the document at the time the document was captured. *See id.*,

paragraph [0005] ("graphical representations of the documents and applications as viewed on the screen at the time of 'capture'") (emphasis added); paragraph [0030] ("File Snapshot 305 includes a miniaturized graphical depiction of the screen at the time the document and/or application is open and was 'captured', using a screen capture of the active window") emphasis added); paragraph [0031] ("graphical thumbnail image of the document at the point of capture") (emphasis added).

Because the "file snapshot" in the Swart reference is a graphical representation of a document when it was captured, the Swartz reference fails to teach or suggest providing a extracted graphical representation that includes the content currently within an open application window. For example, if a user employing the system in the Swartz reference changes the content of a document after capturing the document, the "file snapshot" will not match the content that is currently within the document. This is a significant disadvantage in the system of the Swartz reference because if the content of a document is sufficiently changed, the user may not be able to discern which "file snapshot" is associated with a currently open application window. Accordingly, claim 21 of the present application presents significant advantages by providing a graphical representation of content currently within an open application window and, as such, advances the state of the art over the cited references.

Furthermore, in contrast to the Swartz reference, claim 21 of the present invention does not require a user to manually capture a "file snapshot." Instead, the extracted graphical representation is automatically provided upon receipt of a switching input without any previous manual capture by a user. Accordingly, even if the Swartz reference were combined with the Richard and Krause references, the combination of references would not result in the invention of claim 21 as a user would have to manually capture each of the open application windows.

Accordingly, Applicants respectfully submit that the references fail to teach or suggest all of the limitations of claim 21, and, thus, a *prima facie* case of obviousness has not been established.

For the reasons stated above, Applicants respectfully submit that claim 21 is non-obvious over the Richard reference in view of the Krause reference and further in view of the Swartz reference. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 21 under 35 U.S.C. § 103(a). Claim 21 is believed to be in condition for allowance and such favorable action is respectfully requested.

I. Rejections based on Richard, Krause, Kitami, and Swartz

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Richard reference, in view of the Krause reference, in view of the Kitami reference, and further in view of the Swartz reference.

The rejection of claim 22 relies in part on the combination of the Richard and Krause references similar to the rejections for claims 1, 2, 7, 8, 15, 16, and 23. Accordingly, claim 22 is believed to be in condition for allowance for at least the above-cited reasons. In addition, the rejection of claim 22 relies in part on the combination of the Kitami reference with the Richard and Krause references similar to the rejections for claims 5, 6, 9, 10, 12-14, 18, and 19. Accordingly, claim 22 is believed to be in condition for allowance for at least the above-cited reasons. Further, the rejection of claim 22 relies in part on the combination of the Swartz reference similar to the rejection for claim 21. Accordingly, claim 22 is believed to be in condition for allowance for at least the above-cited reasons.

For the reasons stated above, Applicants respectfully submit that 22 is non-obvious over the Richard reference, in view of the Krause reference, in view of the Kitami reference, and further in view of the Swartz reference. Accordingly, Applicants respectfully

request withdrawal of the rejection of claim 22 under 35 U.S.C. § 103(a). Claim 22 is believed to be in condition for allowance and such favorable action is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 1-24 are now in condition for allowance. Applicant respectfully requests withdrawal of the pending rejections and allowance of claims 1-24. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required (or to credit any overpayment) to Deposit Account No. 19-2112.

Respectfully submitted,

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